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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,028

02/03/2004

Charles Eglinton

001-300

2027

29569

7590

12/14/2007

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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

4143

MAIL DATE

DELIVERY MODE

12/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,028	<b>Applicant(s)</b> EGLINTON, CHARLES	
	<b>Examiner</b> Nathan C. Uber	<b>Art Unit</b> 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3 February 2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 3 February 2004.
2. Claims 1-20 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statement filed on 3 February 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### **Drawings**

4. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
5. Figures 3, 4 and 5 are objected to because they are not legible.
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: *Advertiser 130* (see the last line of ¶0077).
7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Specification**

8. The disclosure is objected to because of the following informalities: the specification is replete with grammatical errors that make the specification difficult to read and understand, and several paragraphs are simply repeated verbatim throughout the specification. The above informalities diminish the clarity and conciseness of the specification. Appropriate correction is required.
9. The use of the trademarks Windows, Perl, ASP and Javascript (see at least ¶¶0067 and 0073) has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

### **Oath/Declaration**

10. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It was not executed in accordance with either 37 CFR 1.66 or 1.68.

### **Claim Objections**

11. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

### **Claim Rejections - 35 USC § 112**

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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13. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claims 1-20 are vague and indefinite because the claims all employ the passive voice using the phrase "having a/said..." followed by a noun and a verb. Whenever the passive voice is employed it is unclear whom or what is doing an action. Here the nouns alternate between "user" (see at least Claim 1) and "advertisement" (see at least Claim 8). While it is conceivable that a user can complete an action it is unlikely that an advertisement can complete an action. As claimed one of ordinary skill cannot determine whether the system is ultimately responsible for the actions of the user and the advertisements, or whether the users are supposed to be interacting with the system. Additionally this is a system with no components only steps.
15. Claims 8-13, 17 and 20 recites the limitation "advertisement". There is insufficient antecedent basis for this limitation in these claims.
16. The term "postage" in claim 14 is a vague term that renders the claim indefinite. The term "postage" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite definition, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Applicant discusses both physically posting printed advertisements and mailing advertisements, but there is very little detail about either option. The word postage is not used in the specification; the specification therefore does not set out the appropriate way to interpret this claim. Thus examiner interprets "postage" in its common usage, e.g. stamps.
17. The term "telephone system" in claim 16 is a vague term that renders the claim indefinite. The term "telephone system" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite definition, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Applicant broadly addresses all possible *tangible and electronic methods of delivery* in ¶0073, however this paragraph is directed to *print advertising* and fails to discuss dissemination via telephone. One of ordinary skill could describe

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the contents of an advertisement they see online over the telephone to another person, but it is not clear how such a transmission is associated with applicant's invention. Telephone systems are not mentioned at all in the specification; the specification therefore does not set out an appropriate way to interpret this claim. Examiner thus interprets "telephone system" as an electronic medium within which voice communications are transmitted and received.

18. The phrase "tangible print media" in claims 3 and 17 is a vague term that renders the claim indefinite. The term "tangible print media" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite definition, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Applicant particularly defines "tangible media" in the specification. The "tangible print media" of the claims however appears to depend from the *advertising* of previous limitations. Such *advertising* is *virtual advertising* according to the claims. Customarily *virtual advertising* is not tangible by definition, so applicant must not be referring to "tangible media" as defined when applicant uses the phrase "tangible print media." However the phrase remains undefined and thus renders the claims vague and indefinite. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "tangible print media" in claims 3 and 17 is used by the claim to mean "virtual advertising", while the accepted meaning is "physical/printed form." The term is indefinite because the specification does not clearly redefine the term.

#### Claim Rejections - 35 USC § 101

19. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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20. Claims 1 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Both claims are directed to *an internet-based system*. "System" is commonly used to denote a machine. Here claim is not directed to a machine, but rather to a program or code. Internet-based applications, programs and code are not statutory subject matter. Alternatively, processes and "computer-executable programs tangibly embodied on a computer readable medium" may be considered statutory subject matter under 35 U.S.C. 101.
21. Claims 1-20 are rejected under 35 U.S.C. 101 because the claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), at 1551. See also MPEP 2173.05(p)(II). Every claim contains the language "system," which denotes a machine, and the phrase "having a/said user/advertisement..." followed by a verb, which denotes some sort of method or process.
22. Claims 6, 7 and 19 are rejected under 35 U.S.C. 101 because the claimed recitations of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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24. Claims 1-7 and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanborn et al., US 2002/0022996 A1.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1 and 17:**

Sanborn, as shown, discloses the following system limitations:

- *having a user connect to a website* (see at least Figure 6 and ¶0081),
- *having said user select a webpage* (see at least ¶0018, "the user has selected an image")
- *allowing virtual advertising to be delivered to said user* (see at least the Abstract, "the producer (a service provider) employing this method then prints and mails the product to the indicated address").

**Claims 2 and 17:**

Sanborn, as shown, discloses the following system limitation:

- *said advertising being printed through a printing means* (see at least ¶0020, "production on a suitable printing device").

**Claims 3 and 17:**

Sanborn, as shown, discloses the following system limitation:

- *said advertising being tangible print media* (see at least ¶0033, "a tangible product that is mailed").

**Claims 4 and 17:**

Sanborn, as shown, discloses the following system limitation:



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- *said advertising dynamically merged with a code that will identify who placed the advertisement* (see at least ¶0051, “modify the...association with advertiser images”).

**Claims 5 and 18:**

Sanborn, as shown, discloses the following system limitation:

- *said user contact the system through the Internet* (see at least Figure 6 and ¶0081).

**Claims 6 and 19:**

Sanborn, as shown, discloses the following system limitation:

- *said user connect to the system through the use of a computer* (see at least ¶0037, “the computer process”).

Sanborn does not explicitly state that a user connects to the system via a computer, however, as shown, the system is a computer system and it relies on at least one computer in order to operate. It is therefore implicit that any user of the system connecting to the system for purposes of using it must connect through a computer.

**Claim 7:**

Sanborn, as shown, discloses the following system limitation:

- *said user connect to the system through the use of a computer through the Internet* (see at least Figure 6 and ¶¶0081 and 0037, “the computer process”).

**Claim 14:**

Sanborn, as shown, discloses the following system limitation:

- *said user to choose the method of postage* (see at least ¶0033, “a tangible product that is mailed:...;electronic communications”).

**Claim 15:**

Sanborn, as shown, discloses the following system limitation:

- *said advertising being delivered through electronic mail* (see at least ¶0033, “a tangible product that is mailed:...;electronic communications”).

**Claim 16:**

Sanborn, as shown, discloses the following system limitation:

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- *said advertising being delivered through a telephone system* (see at least ¶0033, “telephone”).

**Claim 20:**

Sanborn, as shown, discloses the following system limitation:

- *said advertisement being uniquely identified* (see at least ¶0016).

**Claim Rejections - 35 USC § 103**

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

27. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanborn et al., US 2002/0022996 A1.

**Claims 9, 11 and 13:**

Sanborn, as shown, discloses the following limitation:

- *said advertisement being uniquely identified* (see at least ¶0016).

**Claims 8-9:**

Sanborn, as shown, discloses “[t]he product could take many forms: a tangible product that is mailed: postcard, flyer, letter...” Sanborn does not specifically disclose:

- *tabbed flyers*.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention of Sanborn to create *tabbed flyers* as needed because *tabbed flyers* were well known and in general use at least by the time of this invention.

**Claims 10-11:**

Sanborn, as shown, discloses “[t]he product could take many forms: a tangible product that is mailed: postcard, flyer, letter...” Sanborn does not specifically disclose:

- *business cards*.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention of Sanborn to create *business cards* as needed because customized *business cards* were well known and in general use at least by the time of this invention.

**Claims 12-13:**

Sanborn, as shown, discloses “[t]he product could take many forms: a tangible product that is mailed: postcard, flyer, letter...” Sanborn does not specifically disclose:

- *posters*.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention of Sanborn to create *posters* as needed because customized *posters* were well known and in general use at least by the time of this invention.

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### **Conclusion**

- 28.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.272.6710**.
- 29.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 30.** Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

- 31.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 4143

26 November 2007

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143